

**REMARKS**

Applicant gratefully acknowledges the Examiner for her helpful suggestions provided to the Applicant during the personal interview with the Applicant's undersigned representative on September 23, 2003. As noted in the Interview Summary Sheet, during the interview the parties discussed adding a display device for displaying a menu for transmitting/receiving the data. Applicant notes that by this Amendment, this feature has been added to independent claims 1, 4, 7 and 15.

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 1-20 are all the claims presently pending in the application. Claims 1-5, 7 and 14-15 have been amended to more clearly define the invention. Claims 1, 4, 7 and 15 are independent.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-3, and 7-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz, et al. (USPN 6,330,244), and further in view of Sashihara (USPN 6,434,405). Claims 4-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara, and further in view of Swartz, et al. Claims 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich (USPN 6,317,609), further in view of Swartz, et al., and further in view of Sashihara. Claims 9-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sashihara, further in view of Swartz, et al., and further in view of Alperovich.

These rejections are respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention as defined, for example, in claim 1, is directed to a wireless telephone that receives data of at least one of an image and characters through a transmitting

provider. The wireless telephone includes a detector for detecting the data received from the transmitting provider, a designating device for designating the data for reception by the wireless telephone from the transmitting provider and for selectively designating an apparatus to which the received data is to be transmitted, and a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by the designating device. Importantly, the claimed telephone also includes a display device for displaying a menu for designating at least one of transmitting data and receiving data.

Conventional telephones may include a display device. However, such conventional phones do not provide a user with an ability designate one of transmitting or receiving data. Thus, the display device in conventional telephones does not display a menu for designating at least one of transmitting data and receiving data.

The claimed invention, on the other hand, provides a user with an ability designate at least one of transmitting and receiving data. Thus, the display device in the claimed telephone displays a menu for designating at least one of transmitting data and receiving data. For example, when the telephone detects data which may be received/transmitted, a user may view the menu on the display device and use a designating device to designate whether the data should be received by the telephone or transmitted to a designated apparatus.

## **II. THE PRIOR ART REFERENCES**

### **A. The Swartz and Sashihara References**

The Examiner alleges that Swartz would have been modified by the teachings of Sashihara to form the claimed invention of claims 1-3 and 7-8, and that Sashihara would have been modified by the teachings of Swartz to form the claimed invention of claims 4-6. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Swartz discloses a wireless local area network for digital radio communication between remote devices and a private branch exchange (PBX) telephone system. Further, a wireless phone is provided for voice and data communication through the PBX or a central

office (CO) telephone line with remote locations or the Internet using digital data packets and standard Internet Protocol (Schwartz at Abstract).

Sashihara, on the other hand, discloses a transmitting and receiving card selectively attached to a portable phone or an information terminal. When the card is attached to the portable phone, the card as the information terminal so as to retrieve information such as e-mail stored in a server via the portable phone, and to transmit information stored in advance in the card to such a server according to a request (Sashihara at Abstract).

However, Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, these references are directed to different problems and solutions. Specifically, Schwartz is intended to provide an improved system for connecting a wireless local area network (LAN) or wide area network (WAN) to a private branch exchange (PBX) (Schwartz at col. 1, lines 49-51), whereas Sashihari is merely intended to allow a portable phone to mail server without using a cable. Therefore, these references are completely unrelated, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that it would have been obvious to combine these references to avoid the inconvenience of using a cable/line connection. However, the Examiner's stated motivation to combine is completely unrelated to at least one objective of the claimed invention (e.g., transmitting data to an apparatus without using a transmitting provider) and, therefore, is insufficient to support the alleged combination.

Moreover, neither Schwartz, nor Sashihara nor any combination thereof teaches or suggests "a display device which displays a menu for designating at least one of transmitting data and receiving data" as recited, for example, in claim 1.

As noted above, conventional telephones may include a display device. However, such conventional phones do not provide a user with an ability designate one of transmitting or receiving data. Thus, the display device in conventional telephones does not display a menu for designating at least one of transmitting data and receiving data.

The claimed invention, on the other hand, provides a user with an ability designate at

least one of transmitting and receiving data (Application at page 4, line 25-page 5, line 13). Thus, the display device in the claimed telephone displays a menu for designating at least one of transmitting data and receiving data (Figure 4). For example, when the telephone detects data which may be received/transmitted, a user may view the menu on the display device and use a designating device to designate whether the data should be received by the telephone or transmitted to a designated apparatus (Application at page 5, lines 17-26).

Clearly, the cited references do not teach or suggest these novel features. Indeed, neither of these references even discuss at least one problem (e.g., transmitting data to an apparatus without a transmitting provider) which the claimed invention is intended to address.

Moreover, the Examiner attempts to rely on Schwartz at col. 7, line 33-col. 8, line 65 and col. 15, lines 29-51 to support her allegations. However, these passages clearly do not teach or suggest the display device of the claimed invention, including a menu for designating at least one of transmitting data and receiving data.

Indeed, Schwartz merely states that the phone has a screen for “displaying text and graphics” (Schwartz at col. 7, lines 34-35), and that “[d]ata displayed on the terminal’s display will include ‘links’ to other information” (Schwartz at col. 7, lines 52-54). Thus, the screen in Schwartz merely displays “links” and does not display a “menu”. That is, in Schwartz the user is not given an option of whether to “transmit” data to an apparatus. Therefore, the screen only displays “links” that the user can “click” on to receive data. This is completely different and unrelated to the claimed telephone which allows a user to either receive the data or transmit the data to a designated apparatus, and therefore, displays a **menu** for designating at least one of transmitting data and receiving data.

Further, column 15 in Schwartz is merely directed to a “menu” button which causes a display 801 (e.g., see Schwartz at Figure 9A) to display “a set of menus which can be used to send and display page messages, configure the phone’s network parameters, perform diagnostics, examine statistics, etc.” (Schwartz at col. 15, lines 31-34). However, again this is unrelated the claimed device which displays a **menu** for designating at least one of transmitting data and receiving data.

Similarly, Sashihara does not teach or suggest these features. Indeed, Applicant notes that the Examiner has not even relied upon Sashihara as disclosing this feature, but relied on

Sashihara for reasons which are completely unrelated to a display device.

Indeed, Sashihara may disclose a display device. However, Sashihara, like Schwartz does not give a user an option of receiving data or transmitting data to a designated apparatus. Therefore, Sashihara does not have a need to display a menu for designating at least one of transmitting data and receiving data. In fact, Sashihara merely states that “[i]f a display device for displaying information the contents of e-mail is provided in the portable phone 3, the e-mail retrieved by using portable phone 3 and stored in the transmitting and receiving card 4 can be shown to the user” Sashihara at col. 6, lines 29-33). In other words, the display device merely displays the contents of e-mail and is completely unrelated to the display of the claimed invention which displays a menu for designating at least one of transmitting data and receiving data. Indeed, nowhere is this taught or suggested by Sashihara.

Therefore, Applicant respectfully submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

#### **B. The Alperovich Reference**

The Examiner alleges that Alperovich would have been modified by the teachings of Schwartz, and that the Alperovich/Schwartz combination would have been further modified by the teachings of Sashihara to form the claimed invention of claims 15-20. The Examiner also alleges that Sashihara would have been modified by the teachings of Schwartz, and that the Sashihara/Schwartz combination would have been further modified by the teachings of Alperovich to form the claimed invention of claims 9-14. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed method OR invention.

Alperovich discloses a telecommunications system for transmitting digital images produced by a digital camera attached to or integrated with a mobile station (MS) from the MS to a receiving terminal through the Internet (Alperovich at Abstract).

However, Applicant submits that Alperovich would not have been combined with Schwartz and Sashihara as alleged by the Examiner. Indeed, these references are directed to

different problems and solutions. Specifically, Alperovich is directed to a system for transmitting digital images which allegedly improves the quality of a digital image by reducing the load on the cellular and fixed networks (Alperovich at col. 3, lines 49-53). This is completely unrelated to the systems of Schartz and Sashihara. Therefore, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that it would have been obvious to combine these references to “transfer the image/data file to another peripheral device when the wireless phone doesn’t have enough capacity to load the entire sent data”. However, Alperovich is intended to reduce the load on a network, and does not address a capacity of a wireless telephone. Therefore, the Examiner’s allegations are insufficient to support the alleged combination.

Moreover, neither Schwartz, nor Sashihara, nor Alperovich, nor any combination thereof teaches or suggests “a display device which displays a menu for designating at least one of transmitting data and receiving data” as recited, for example, in claim 1.

As noted above, unlike conventional telephones the claimed invention provides a user with an ability designate at least one of transmitting and receiving data (Application at page 4, line 25-page 5, line 13). Thus, the display device in the claimed telephone displays a menu for designating at least one of transmitting data and receiving data (Figure 4).

Clearly, Alperovich does not teach or suggest these novel features. Indeed, Alperovich does not even discuss at least one problem (e.g., transmitting data to an apparatus without a transmitting provider) which the claimed invention is intended to address.

Further, Alperovich may disclose a display 28 (Alperovich at Figure 3). However, the display merely displays a “menu” 27 which reads “SEND DIGITAL IMAGE WITH CALL”. Alperovich states that the user “can select to send one or more of the digital images 355 along with a call setup request for transmitting speech by viewing” the menu (Alperovich at col. 4, lines 40-46). Clearly, this is unrelated to the display device and menu of the claimed invention.

In fact, Alperovich does not teach or suggest a display device which displays a menu

for designating at least one of transmitting data and receiving data. Therefore, Alperovich does not make up for the deficiencies of the alleged Schwartz/Sashihara combination.

Therefore, Applicant respectfully submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

### III. FORMAL MATTERS AND CONCLUSION

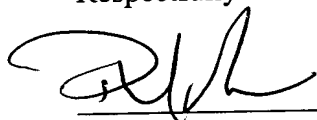
In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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Phillip E. Miller  
Registration No. 46,060

**McGinn & Gibb, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
**Customer No. 21254**